

REMARKS

Reconsideration of the application as amended is requested. Claims 40-50, 95-138, and 150-170 have been deleted such that the rejections of these claims are now believed to be moot.

In the Office Action dated May 9, 2007, the drawings were objected to with respect to the rod being molded at least partly around the magnet (claim 82), and keyless ignition component (claim 120). Claim 120 has been cancelled, such that this objection is believed to be moot. At paragraph [0047], the present application incorporates by reference U.S. Patent No. 7,221,248. The features of claim 82 are shown in the '248 patent (e.g., Fig. 4). Applicant notes that "essential material" may be incorporated by reference to a U.S. patent. (MPEP 608.01(p); 37 C.F.R. §1.57(c)). Accordingly, the requirements of 37 C.F.R. §1.83(a) are believed to be met.

The specification was also objected to for "failing to provide proper antecedent basis for the claimed subject matter." The specification has been amended at paragraph [0056] to clarify that pin 41 may comprise a first member, and the specification has also been amended at claim 82 to clarify that the connecting rod 102 (Fig. 19, 20) may comprises a first member, and that the roller 103 may comprise a pawl member. Similarly, paragraph [0050] has been amended to clarify that the button 16 may comprise a manually movable operator input device or member. Claims 69, 90, 93 and 94 have been amended to recite a "pawl member," such that the wording of these claims is now consistent with the specification and wording of other claims. These amendments to claims 68, 90, 93 and 94 are not believed to alter the scope of these claims in any way. Claim 118 has been deleted, such that the objection to this claim is now believed to be moot.

In the Office Action dated May 9, 2007, claims 23 and 51 were rejected under 35 U.S.C. §112, first paragraph, as "failing to comply with the written description requirement... . The specification does not provide support for a vehicle operating parameter other than a vehicle ignition and a position of a vehicle brake pedal. In fact the specification clearly states that one of the operating parameters is indeed the position of the brake pedal (paragraph [0063]). MPEP 2173.05(i)."

As an initial matter, Applicant notes that claims 23 and 51 do not recite that the brake pedal position is not used to control the powered pawl. Claims 23 and 51 simply recite that the controller utilizes a vehicle operating parameter other than the vehicle ignition and the position of the brake pedal. (As discussed in more detail below, these claims have also been amended to recite "a position of the shift member.") Thus, claims 23 and 51, as filed, recite control of a powered pawl based on at least one operating parameter other than a vehicle ignition and a position of a brake pedal, and this could include, for example, control based on vehicle speed wherein the controller also controls the pawl based on a position of brake pedal and a vehicle ignition. Alternately, claims 23 and 51, as filed, could also cover a shifter including control of the powered pawl based on a vehicle's speed wherein the powered pawl is not controlled by brake pedal position and vehicle ignition.

Applicant respectfully asserts that the specification as filed does include support for control of a powered pawl utilizing vehicle operating parameters other than vehicle ignition and position of a vehicle brake pedal. For example, paragraph [0063] of the present application as filed states that "Thus, controller 20 could actuate solenoid 12 if the vehicle is moving forward at, for example, 10 mph, and the operator attempts to move the shift lever 4 to the "3" gear position, but controller 20 would not actuate solenoid 12 to permit movement to the REVERSE position based upon the direction of movement of shift lever 4 and the vehicle operating parameters (e.g., vehicle speed)." Paragraph [0064] of the present application states that the "raised portion 33B between the PARK and REVERSE gear positions may have a height requiring full retraction of pawl 15 that would only occur if the controller determined that the vehicle was not moving. Controller 20 could also utilize other vehicle operating parameters such as engine rpm or the like to control the degree of retraction of pawl 15. Also, controller 20 may be configured such that shifting out of PARK requires that the pedal be depressed and that a key be in the ignition in the run position."

Applicant again points out that claims 23 and 51 do NOT recite that the controller does not utilize vehicle ignition and position of a vehicle brake pedal in controlling the powered pawl; rather, these claims positively recite that the controller utilizes a vehicle

operating parameter other than (e.g., in addition to) a vehicle ignition and vehicle brake pedal. Claim 23 has been further amended to clarify that the vehicle operating parameter utilized by the controller is in addition to vehicle ignition, position of the shift member, and a position of a vehicle brake pedal.

In the Office Action of May 9, 2007, claims 23, 28, 29 and 51 were rejected as being indefinite under 35 U.S.C. §112, second paragraph.

Claim 28 has been amended to recite a manually-movable input member on the shift member, such that there is now sufficient antecedent basis for the term "said input member" in claims 28 and 29.

Applicant notes that MPEP 2173.05(i) states that "the current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation." (emphasis added.) The specification as filed provides numerous examples of vehicle operating parameters other than/in addition to a vehicle ignition, a position of a shift lever, and a position of a vehicle brake pedal, and claims 23 and 51 are therefore believed to be clear and definite when considered in view of the specification. Applicant respectfully asserts that in the present application, it is no more difficult to determine the coverage of the claim if an element is recited positively or negatively; the scope of the term would still need to be determined.

In the Office Action dated May 9, 2007, claims 1-6, 23, 26-30, 35-37, 51-57, 59, 85, 90-94, 110-114, 117-119, 139-145, 148 and 149 were rejected under 35 U.S.C. §102(e) as being anticipated by Russell, U.S. Patent Application No. 2004/0244524 (filed April 15, 2003), and claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Russell '524 in view of Ruiters, U.S. Patent No. 5,220,984, claims 12 and 58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Russell '524 in view of Kito, U.S. Patent No. 4,947,967, claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Russell in view of Kato, U.S. Patent No. 6,679,809, claims 25, 146 and 147 were rejected under 35 U.S.C. §103(a) as being unpatentable over Russell '524 in view of Durieux, U.S. Patent No. 6,059,687, claims 31-33, 86-89, 115 and 116 were rejected under 35 U.S.C. §103(a) as being unpatentable over Russell '524 in view of Rossetti, U.S. Patent No. 5,387,892, claims 60 and 62-69 were rejected

under 35 U.S.C. §103(a) as being unpatentable over Russell '524 in view of Kito, U.S. Patent No. 4,947,967, claims 80-84 were rejected under 35 U.S.C. §103(a) as being unpatentable over Russell '524 in view of van Namen, U.S. Patent No. 6,512,435, and claims 120-124 and 150-153 were rejected under 35 U.S.C. §103(a) as being unpatentable over Russell '524 in view of Kumazaki, U.S. Patent Application No. 2003/0135321.

Applicant has submitted with this Amendment, a Declaration Under 37 C.F.R. §1.131 to anti-date the Russell '524 publication and thereby remove it as a reference. As will be apparent in the Declaration, Applicants conceived of the invention of at least claims 1, 2, 4-6, 12, 13, 60-63, 65-68 and 90-94 prior to the filing date of the Russell '524 publication/application, and exercised diligence from before the filing date of the Russell '524 publication/application until filing of United States Provisional Patent Application No. 60/470,609 on May 15, 2003. The present application claims the benefit under 35 U.S.C. §119(e) of the filing date of U.S. Provisional Application No. 60/470,609. In light of the fact that the filing date of the Russell '524 patent publication/application may no longer be considered as a reference as to claims 1, 2, 4-6, 12, 13, 60-63, 65-68 and 90-94 of the present application, the rejection of these claims has now been rendered moot.

Claims 3 and 7 depend from claim 1, such that the rejections of these claims based on Russell '524 are also believed to be moot.

Claims 64 and 69 depend from claim 60, such that the rejections of these claims based on Russell '524 are also believed to be moot.

With respect to independent claim 23, as discussed above, claim 23 has been amended to recite a controller that actuates a powered pawl based at least in part on at least one vehicle operating parameter in addition to an input from a vehicle ignition, a position of a shift member, and a position of a vehicle brake pedal. As discussed above, the vehicle operating parameter could be a vehicle velocity or direction, or one or more other vehicle operating parameters. Applicant respectfully asserts that Russell '524 does not disclose any such arrangement. Specifically, "other" (Fig. 8) of Russell '524 relates to a position of a shift lever assembly/transmission switch 108. Although Russell

'524 does disclose control of a solenoid utilizing an ignition switch 120, a transmission switch 108, and a brake switch 128, Russell '524 does not disclose use of one or more vehicle operating parameters such as vehicle speed, direction, engine rpm, or the like. Accordingly, Applicant respectfully asserts that Russell '524 cannot anticipate amended claim 23.

Claims 24-29 depend from claim 23, and are therefore believed to be allowable for those reasons set forth above in connection with independent claim 23.

With respect to independent claim 30, the Office Action stated that "said solenoid (56, a solenoid uses magnets) is biased into said engaged position." As an initial matter, Applicant notes that solenoids do not necessarily include magnets. Furthermore, Russell '524 does not explicitly disclose a solenoid having a magnet biasing a movable member into a rest position as recited in claim 30. Applicant notes that "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" MPEP 2112(IV), citing *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)) (emphasis added). Given that solenoids do not necessarily include a magnet biasing a movable member into a rest position as recited in claim 30, Russell '524 cannot anticipate claim 30. In fact, Russell '524 actually teaches a spring 98 that "pivots the links 58, 60 to linearly move the pawl 54 back to the locking position" when the solenoid 56 is unactivated. [0034]. Thus, Russell '524 actually teaches away from use of a magnet, and this is directly contrary to claim 30.

Claims 31-39 depend from claim 30, and are therefore believed to be allowable for those reasons set forth above in connection with claim 30.

As discussed above, independent claim 51 has been amended to recite a controller that controls a powered pawl mechanism based at least in part upon at least

one vehicle operating parameter other than the position of a brake pedal, a position of the shift member, and a vehicle ignition. As discussed above in connection with independent claim 23, Russell '524 discloses use of an ignition switch 120, a transmission switch 108, and a brake switch 128 (Fig. 8). However, Russell '524 does not disclose control of a powered pawl utilizing one or more other vehicle operating parameters such as a vehicle speed, direction, engine rpm, or other vehicle operating parameter(s). Applicant again notes that claim 51 does not recite that the controller does not utilize a brake pedal, shift lever position, and vehicle ignition to control the powered pawl. The powered pawl may, indeed, be controlled, at least in part, based on inputs related to the brake pedal, shift member, and vehicle ignition; the shifter of claim 51 does, however, include control based on at least one other vehicle operating parameter. Applicant respectfully asserts that Russell '524 does not in any way disclose or suggest such an arrangement.

Claims 52-59 depend from claim 51, and are therefore believed to be allowable for those reasons set forth above in connection with claim 51. With respect to independent claim 85, this claim recites that the solenoid includes "a magnet biasing the solenoid to the rest position." In contrast, Russell '524 teaches a spring member 98 as discussed at paragraph 34 of Russell '524. Applicant again points out that solenoids do not necessarily include a magnet, and inherency requires that "the missing descriptive matter is necessarily present in the thing described in the reference. MPEP 2112(IV) (emphasis added). Accordingly, independent claim 85 cannot be anticipated by Russell '524.

Claims 86-89 depend from claim 85, and are therefore believed to be allowable for those reasons set forth above in connection with claim 85.

Independent claim 90 recites a shifter for vehicles including a powered pawl having a linearly-movable output member that shifts along an axis and a pawl member "resiliently coupled" to the output member such that the engagement member engages the shift gate and the stop surface upon application of a force to the shift member when the pawl is in the engaged position to thereby transfer forces into the base.

With reference to paragraphs [0056] and [0057] of the present application, and Fig. 5, a resilient pad 43 may be utilized to interconnect a pawl 15A relative to a pin 41 to permit transfer of loads from a movable gate 10 into a base 2 without excessively loading solenoid 12. Applicant respectfully asserts that Russell '524 does not disclose "a pawl member resiliently coupled to the output member" as recited in claim 90. The Office Action of May 9, 2007, states that Russell discloses "said powered pawl having a movable pawl including a first member (58) and a pawl member (54) is resiliently and elastically (everything is elastic as it has some yield) connected to the first member (moves with 58)" Applicant respectfully asserts that it is improper to construe claim terms in such a way that certain features of the claim are given no weight whatsoever. During prosecution claim terms cannot be contorted without bound in an unreasonable manner: "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." MPEP 2111 (emphasis added). MPEP 2111.01(I) states that "words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification." Furthermore "'plain meaning' refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art." MPEP 2111.01(II).

Furthermore, as discussed above, claim 90 recites that "the engagement member engages the shift gate and the stop surface upon application of a force to the shift member when the pawl is in the engaged position to thereby transfer forces into the base." The Office Action of May 9, 2007 does not even assert that Russell '524 discloses any such arrangement, such that Applicant is unable to determine the Examiner's position with respect to this portion of claim 90. Applicant points out that "a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." MPEP 2173.05(g). Applicants respectfully request that the Examiner consider the invention as a whole, including all functional limitations. See also MPEP 2141.02(I). ("The claimed invention as a whole must be considered").

Applicant respectfully asserts that Russell '524 cannot anticipate claim 90 when claim 90 is properly construed as it would be by those skilled in the art. To the extent

one skilled in the art would construe everything to be elastic, Applicant respectfully requests that the Examiner a reference showing that one skilled in the art would construe everything to be elastic such that any such claim recitation is completely meaningless.

Claims 91-94 depend from claim 90, and are therefore believed to be allowable for those reasons set forth above in connection with claim 90.

Independent claim 139 recites a powered pawl including a movable pawl member that defines first, second, and third distinct positions. A controller is configured to selectively control the position of the movable pawl member and selectively shift and retain the pawl member in the first, second and third positions. Support for the amendments to claim 139 can be found at, for example, Fig. 10 of the present application, and paragraph [0062] of the present application. Solenoids that extend specific distances depending upon the amount of current applied to the solenoid are believed to have been known at the time the present application was filed, such that the requirements of 35 U.S.C. §112, first paragraph, are believed to be met by the present application.

Applicant respectfully asserts that Russell '524 does not disclose a controller that shifts and retain a pawl member in first, second, and third positions. Rather, Russell '524 is only retained in one of two positions. Thus, Russell '524 cannot anticipate amended claim 139.

Claims 140-149 depend from claim 139, and are therefore believed to be allowable for those reasons set forth above in connection with independent claim 139.

With respect to claims 80-84, Applicant notes that the Office Action of May 9, 2007 states that "Russell discloses... a rod (90) movably mounted within the housing, the rod" due to this sentence fragment, it is unclear to Applicant what Russell purportedly discloses.

Independent claim 80 has been amended to recite a solenoid having resilient material fixed to a rod that is movably mounted within a housing. The magnet is encapsulated by the resilient material to form an integral damper to reduce noise. Applicant respectfully asserts that neither Russell '524 nor van Namen '435 disclose

such an arrangement. Specifically, the moving armature 14 of van Namen '435 moves within bobbin 16. van Namen '435 does not disclose a magnet that is encapsulated by resilient material fixed to a rod that is movably mounted within a housing as recited in claim 80.

Claims 81-84 depend from claim 80, and are therefore believed to be allowable for those reasons set forth above in connection with claim 80. Furthermore, claim 82 recites that the rod is made of a polymer material molded at least partly around the magnet. In contrast, van Namen '435 states that "pin 14B is made of a non-magnetic material typically non-ferrous metal, and, an illustrative embodiment is made to extend entirely through a central channel and magnet 14A as shown." Thus, van Namen '435 actually teaches a rod made of a metal material, in direct contrast to the arrangement of claim 82.

Furthermore, claim 83 recites that the resilient material encapsulating magnet defines a melting temperature, and the polymer material has a melting temperature that is greater than the melting temperature of the resilient material. Applicant can find no disclosure for this arrangement in van Namen '435. The Office Action of May 9, 2007 simply states that "different materials have different melting points." However, van Namen '435 does not disclose a resilient material encapsulating a magnet of a polymer rod wherein the movable polymer rod is made of a material having a melting temperature greater than the melting temperature of the resilient material. Clearly, simply asserting that different materials have different melting temperatures does not provide a disclosure of the arrangement of claim 83.

Claim 84 recites that the polymer material extends along at least a portion of the side faces of the magnet to retain the magnet. Applicant again notes that van Namen '435 states that the pin 14B is made of a non-ferrous metal. Applicant respectfully requests that the Examiner point out specifically wherein van Namen '435 teaches polymer material extending along at least a portion of the side faces of the magnet as recited in claim 84.

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Applicant has made a concerted effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities, the courtesy of a telephone call to the undersigned attorney would be appreciated.

Respectfully submitted,

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